

REMARKS

Discussion of Claim Amendments

Claim 1 has been amended to recite that a binder resin is a polyolefin. Claim 6 has been amended to make it dependent upon claim 1, rather than on claim 5, which has been cancelled. Claims 22 and 73 have been amended to recite that the erasable colored pencil lead composition "forms" a cohesive layer rather than the erasable colored pencil lead composition is "capable of forming" a cohesive layer, in order to expedite the prosecution of this application. Claims 31 and 82 have been amended by replacing "mixtures" with --combinations--, to track language used in other claims, e.g., claim 29. No new matter has been added.

The Office Action and Response

The Office Action indicated that claims 5-7, 9, and 10 would be allowable if rewritten in independent form. Applicants have amended claim 1 to correspond to the subject matter of claim 5. Claims 4, 6, and 7-10 are directly or ultimately dependent upon claim 1. In view of the foregoing, claims 1, 4, 6, and 7-10 should be allowable.

The Office Action rejected one or more of the remaining claims, either allegedly anticipated by U.S. Patent 5,595,700 (Kitazawa) or JP 02036281 (JP'281) or allegedly unpatentable over Kitazawa or JP '281 in view of secondary references JP 03153778, U.S. Patent 4,371,632 (Grossman et al.), or U.S. Patent 5,716,434 (Koyama). Applicants respectfully traverse these rejections.

The Office Action contends that Kitazawa and JP '281 disclose colored pencil lead compositions that inherently form a cohesive layer. Applicants respectfully submit that the Office Action is in error. The alleged ability to form a cohesive layer does not necessarily flow from the disclosures of Kitazawa and JP '281, as discussed below.

The process of extruding Kitazawa's non-baked colored pencil lead involves, those of ordinary skill in the art would recognize, only moderate temperatures. For example, as set forth in Kitazawa, Example 2, water is added to a blend containing carboxymethylcellulose, talc, pigment, and PTFE powder, and the blend is mixed and dispersed. Water content is adjusted and the blend is pelleted and extruded. The extrudate is then dried to remove water. Since water is present in the extrudate (prior to drying), the extrusion process must involve only moderate temperatures. Those of skill in the art would know that presence of water in the extruder would not allow the extruder to reach high temperatures. Thus, PTFE does not undergo melt processing but merely stays

as a powder. PTFE, as a powder, can act as a lubricant, which is the intended purpose of Kitazawa (see col. 4, lines 8-14, particularly “they are excellent in lubricating properties”). This is further supported by the fact that other materials (lubricants) listed along with PTFE, namely, graphite fluoride and boron nitride also do not melt process under these conditions but merely blend, under Kitazawa’s conditions, as powders, as would be known to those skilled in the art. PTFE also does not melt under the drying temperature of 120° C.

The foregoing shows that the PTFE powder in Kitazawa’s colored pencil lead is not in a form suitable for forming fibrils, and therefore, the colored pencil lead cannot form a cohesive layer.

JP ’281 fails to provide an enabling disclosure; it fails to provide process information adequate to those of ordinary skill in the art to practice the claimed invention. Thus, JP ’281 should not be applied as prior art.

Nevertheless, whatever little JP’ 281 teaches, it teaches just the opposite of the presently claimed invention. JP ’281 requires that a porous inorganic substance must be used to provide attractive qualities to the pencil lead. JP ’281 states that the porous inorganic substance molecules are not structurally cohesive (see second paragraph under “Means to solve the problems” at page 3 of the English language translation, a copy of which was provided previously). JP ’281 states that the qualities of the colored pencil lead (including erasability) were “largely improved” by the combination of the non-porous inorganic filler and the porous inorganic substance or by the use of only porous inorganic substance. As JP ’281 relies on the use of a structurally non-cohesive porous inorganic substance to achieve the desirable qualities including erasability, it does not naturally flow that the lead composition must or could form a cohesive layer.

The Office Action has failed to meet its burden. The alleged property, namely the ability to form a cohesive layer, does not flow undeniably and irrefutably from the disclosures of Kitazawa and JP ’281.

In view of the foregoing, the anticipation rejection over Kitazawa and JP ’281 should be withdrawn.

Further, as the secondary references fail to cure the deficiencies of Kitazawa and JP ’281, the obviousness rejections also should be withdrawn.

In re Appln. of LEIDNER et al.
Application No. 09/828,219

Conclusion

The application is considered in good and proper form for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: October 8, 2003